

Serial No. 09/784,843

AMENDMENTS TO THE DRAWINGS:

Please add the accompanying new drawing sheet, containing new Figure 4, to the Specification.

REMARKS

Claims 1, 5, 7-9, 11, 12, 15, 17-19, 21, 23 and 25-33 remain pending in the application, with claims 1, 11, 29 and 33 being the independent claims. Reconsideration and further examination are respectfully requested.

Certain new rejections and objections have been made in the present Office Action. In the following discussion, these new rejections and objections are addressed first, and then the Examiner's comments in response to the points raised in Applicants' Appeal Brief are addressed.

Rejection under 35 U.S.C. § 101.

Independent claim 33 has been rejected under 35 U.S.C. § 101 as allegedly encompassing software per se. In support of this conclusion, the Office Action first asserts that, "The applicant's specification does not disclose any hardware for performing the specified functions." However, this assertion clearly is not correct.

In fact, Figure 1 shows, and the description of it from page 3 line 31 through page 5 line 27 of the Specification describes, a processor-based system for performing the functions recited in claim 33. For example, page 5 lines 11-13 of the Specification discusses, e.g., "...computer-executable process steps for execution by processor board 12, particularly, process steps for implementing the methods and techniques of the present invention..." Similarly, lines 14-16 on page 5 states, "...the process steps generally will be first downloaded into RAM on processor board 12 (or into extension RAM) and then executed by a CPU on processor board 12 out of such RAM." Thus, the presently recited "means" clearly correspond, e.g., to one or more general-purpose processors executing appropriate software, not to software per se.

Moreover, it would be plainly unreasonable to construe any of the presently recited “means” to encompass software per se because mere software per se is not even capable of performing any functionality. Software necessarily must be implemented on a processor in order to perform any functionality, and the present Specification clearly states that one or more processors, executing software, can be used to implement the claimed methods and techniques.

It is noted that the USPTO is required to give claims their broadest *reasonable* construction. See, e.g., MPEP § 2111. However, as noted above, it is clearly unreasonable to assert that means for performing a specified function reads on software per se, at least absent some clear and unambiguous statement to the contrary.

In addition, the Office Action points to the comment, “It should be understood that any of the functionality described above can be implemented in software...” at page 19, lines 27-30 of the Specification, as allegedly supporting the conclusion that the presently recited means read on software per se. However, particularly in the context of the other portions of the present Specification (e.g., those portions mentioned above), it is clear that this statement simply refers to execution of software by a processor.

It is noted that the word “implemented” that is used in the quotation cited in the Office Action ties back to the word “implementing” in the quotation at page 5 lines 11-13 of the Specification (which is reproduced above). Also, the clause “implemented in software” clearly does not mean the same thing as “implemented by software”, as such clause apparently is being interpreted in the Office Action. Rather, page 5 lines 11-16 of the Specification makes clear that the clause “implemented in software” refers to implementation by a processor executing software.

In short, there is absolutely no indication in the Specification that the presently recited “means” are intended to read on software per se, there is no reasonable basis for altering the ordinary meaning of the expression “means for [performing a specified function]” to encompass software per se, and Applicants clearly did not intend claim 33 to encompass software per se. Accordingly, withdrawal of the present § 101 rejection is respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph.

Claim 33 has been rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Office Action asserts, “...there is no disclosure of what the means for receiving, the means for storing, or the means for at least one of executing or playing comprises.”

In response, it is noted that the recited means for receiving corresponds, e.g., to input device 16 and/or network interface board 18, (as depicted in Figure 1 and described on page 4 lines 20-33 of the Specification), e.g., operating together with a general-purpose processor executing any combination of software and/or firmware stored on a computer-readable medium (as described, e.g., at page 4 lines 20-33, at page 5 lines 10-17 and from page 19 line 27 through page 20 line 4 of the Specification).

The recited means for storing corresponds, e.g., to disc drives 14 (as depicted in Figure 1 and described on page 4 lines 11-28 of the Specification), e.g., operating together with a general-purpose processor executing any combination of software and/or firmware stored on a computer-readable medium (as described, e.g., at page 4 lines 11-28, at page 5 lines 10-17 and from page 19 line 27 through page 20 line 4 of the Specification).

The recited means for at least one of executing or playing corresponds, e.g., to digital video projector 32 (as depicted in Figure 1 and described on page 5 lines 1-4 of the

Specification), e.g., operating together with a general-purpose processor executing any combination of software and/or firmware stored on a computer-readable medium (as described, e.g., at page 5 lines 1-17 and from page 19 line 27 through page 20 line 4 of the Specification).

As indicated above, there is clear support for each of the presently recited “means”. Accordingly, withdrawal of the rejection under § 112, first paragraph, is respectfully requested.

Rejection under 35 U.S.C. § 112, second paragraph.

Claim 33 has been rejected under 35 U.S.C. § 112, second paragraph, based on the recitation of “step (a)”. In response, claim 33 has been amended above to correct this error. Based on the above amendment, withdrawal of the present rejection under § 112, second paragraph, is respectfully requested.

Drawing Objection.

Objection was made to the drawings under 37 CFR § 1.83(a). Specifically, the Office Action states that the apparatus of claims 29-33 must be shown or the feature(s) canceled from the claim(s). In response, a new Figure 4 is being submitted herewith, and corresponding changes are being made to the written portion of the Specification. No new matter is believed to have been added, in light of the fact that new Figure 4 is fully supported by, and merely depicts the language in, the paragraph at page 5 lines 10-17 of the original Specification.

New Figure 4 depicts the processor (CPU 103) and the memory (RAM 102) recited in independent claim 29. The “physical storage medium” recited in claim 29 already was depicted in original Figure 2 (i.e., any of media 61-66). No other apparatus is recited in any of claims 29-32. In addition, the various “means” of claim 33 already are depicted in the originally filed

drawings, e.g., as discussed above in connection with the rejection under 35 U.S.C. § 112, first paragraph.

Based on the new drawing submission, each aspect of the apparatus recited in claims 29-33 is now believed to be shown in the drawings. Accordingly, withdrawal of the drawing objection is respectfully requested.

Response to Examiner's New Comments regarding Prior Art.

The Examiner first indicates that he is reading Applicants' comments in the Appeal Brief to include an assertion that, "Nagai does not teach any transmission to a remote location." However, Applicants were not attempting to make such a broad assertion about *any* transmission. Rather, Applicants were pointing out that there is no indication in Nagai that its "chunk files" (which term Applicants understand the Examiner is reading on the individual media files into which Nagai's multimedia document is divided) are transmitted to any remote location. In other words, Applicants are simply insisting that any proposed mapping of claim terms has to be consistent with respect to all limitations in the claim.

The Examiner next asserts that Applicants are "selectively ignoring the embodiment where all of the media files are sent to the destination." In response, Applicants first note that both embodiments disclosed in Nagai are in fact discussed in the Appeal Brief (on page 8). However, neither such embodiment is described in Nagai as involving the sending of all the media files to a destination, as asserted by the Examiner. Rather, as explained on page 8 of the Appeal Brief, Nagai's first embodiment appears to send just a digest that includes a still image for each "representative scene", and the second embodiment appears to send just new reproduction control information, presumably allowing the recipient to retrieve small clips of the

original content on an on-demand basis. As noted in the Appeal Brief, sending all of the media files presumably would have defeated Nagai's purpose of limiting the amount of bandwidth that is necessary for a recipient to identify those portions of interest to him or her.

Finally, Applicants do not take the position that the Examiner is relying on Panabaker to show all of the recited features. Rather, Applicants merely point out: (1) where certain assertions made about what Panabaker allegedly teaches are not believed to be correct (or that Panabaker teaches more narrowly than is asserted); and (2) that there would have been no motivation to combine Nagai and Panabaker as has been asserted.

For all of the reasons set forth in the Appeal Brief, Applicants continue to believe that the presently pending claims should be allowable over the applied art. In order to sufficiently distinguish Applicant's invention from the applied art, the foregoing remarks emphasize several of the differences between the applied art and Applicant's invention. However, no attempt has been made to categorize each novel and unobvious difference. Applicant's invention comprises all of the elements and all of the interrelationships between those elements recited in the claims. It is believed that for each claim the combination of such elements and interrelationships is not disclosed, taught or suggested by the applied art. It is therefore believed that all claims in the application are fully in condition for allowance, and an indication to that effect is respectfully requested.

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If there are any fees due in connection with the filing of the currently submitted papers that have not been accounted for in this paper or the accompanying papers, please charge the fees to our Deposit Account No. 502490. If an extension of time under 37 C.F.R. 1.136 is required for the filing of the currently submitted papers and is not accounted for in this paper or the accompanying papers, such an extension is requested and the fee (or any underpayment thereof) should also be charged to our Deposit Account.

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Respectfully submitted,  
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